

Applic. No. 10/054,439  
Amdt. dated April 26, 2004  
Reply to Office action of January 26, 2004

Remarks/Arguments:

Reconsideration of the application is requested.

Claims 2, 5, 7, and 8 are now in the application. Claims 2, 5, and 7 have been amended. Claim 8 has been added. Claims 1, 3, 4, and 6 have been cancelled.

In item 2 on page 2 of the Office action, claims 1-7 have been rejected as being obvious over Stein (U.S Patent No. 5,983,795) in view of Gelinas (U.S Patent No. 5,186,103) under 35 U.S.C. § 103.

The rejection has been noted and the claims have been amended in an effort to even more clearly define the invention of the instant application. The claims are patentable for the reasons set forth below. Support for the changes is found in claims 1, 3, 4, and 6 of the instant application and in Fig. 2 of the specification.

It is once again noted that the corporate assignee of the Stein reference is also the assignee of the instant application. Therefore, applicants are very familiar with the reference.

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Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful.

Claims 7 and 8 call for, *inter alia*:

a mounting support for mounting the sheet transport cylinder so that a rotational axis of the sheet transport cylinder is adjustable from a first axial position, which corresponds to a given printing-sheet thickness, to a second axial position, which corresponds to another printing-sheet thickness.

According to the Examiner Stein does not disclose an adjusting device for adjusting the sheet transport cylinder depending upon various printing-sheet thicknesses (web thicknesses). Therefore, the Examiner uses the Gelinas reference in combination with Stein.

The Gelinas reference discloses that it is advantageous to mount the impression cylinder to be adjustable in dependence on the printing material thickness (column 3, lines 34-39). Accordingly, it is applicants' position that a person of ordinary skill in the art would follow the teaching of Gelinas even when combining Stein and Gelinas. A person of ordinary skill in the art might be motivated to modify the impression cylinder (5) disclosed in Stein with the adjusting device

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(30') disclosed in Gelinas. However, a person of ordinary skill in the art would not be motivated to deviate from the disclosure of Gelinas and equip any other cylinder besides an impression cylinder with the adjusting device of Gelinas (i.e. a person of ordinary skill in the art would not modify the sheet transport cylinder disclosed in Stein with the adjusting device of Gelinas). Column 2, lines 34-39 of Gelinas disclose that the adjusting device is meant for adjusting the position of the impression cylinder relative to the rubber blanket cylinder. Stein discloses that the impression cylinder bears the reference numeral "50" and the rubber blanket cylinder bears the reference numeral "4". Therefore, a person of ordinary skill in the art might assign the adjusting device (30') of Gelinas to the impression cylinder (5) of Stein so that it is exactly the impression cylinder (5) of Stein that would be adjustable relative to the rubber blanket cylinder (4).

It is a requirement for a *prima facie* case of obviousness, that the prior art references must teach or suggest all the claim limitations.

The references do not show or suggest a mounting support for mounting the sheet transport cylinder so that a rotational axis of the sheet transport cylinder is adjustable from a

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first axial position, which corresponds to a given printing-sheet thickness, to a second axial position, which corresponds to another printing-sheet thickness, as recited in claims 7 and 8 of the instant application.

The references applied by the Examiner do not teach or suggest all the claim limitations. Therefore, it is believed that the Examiner has not produced a *prima facie* case of obviousness.

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614,1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d

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1453,1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id.

However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125,1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those

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of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein).

Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

Broad conclusory statements standing alone are not "evidence."

Id. When an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F-3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

Upon evaluation of the examiner's comments, it is respectfully believed that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims. Accordingly, the examiner is requested to withdraw the rejection.

Since claim 8 is believed to be allowable, dependent claims 2 and 5 are believed to be allowable as well.

Even though the claims are believed to be allowable the following comments are made in response to the Examiner's response to arguments. Applicants respectfully disagree with the Examiner's comments on page 5 of the Office action that the phase of cylinders is often adjusted to compensate for

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mediums of varying lengths and one of ordinary skill in the art would understand how to adjust the phase of a transport cylinder so that the closing times of the gripper match. The method suggested by the Examiner for correcting the gripper closing time by way of a phase rotation of the cylinder does not work. In his argument, the Examiner fails to consider that the cylinder, the phase position of which he suggests to rotate, cooperates with two other cylinders. It can be seen in Fig. 1 of the instant application that the cylinder 9 cooperates with the upstream cylinder 6, when the cylinder 9 receives sheets from the cylinder 6 and the cylinder 9 cooperates with the downstream cylinder 10 when the cylinder 9 transfers the sheet to the cylinder 10. After repositioning the cylinder 9 in the direction A or B, the gripper closing time as well as the gripper opening time of the grippers on the cylinder 9 must be brought in line (must harmonize) with the gripper operating times of the two neighboring cylinders 6 and 10. The phase rotation suggested by the Examiner would improve the gripper closing time of the cylinder 9; however, it would simultaneously make the gripper opening time of the cylinder 9 even worse. The phase rotation of the cylinder 9 only makes it possible to correct the cooperation of the grippers with only one of the two neighboring cylinders 6, 10. Depending on the rotation direction of the phase rotation, the cooperation of the grippers of the middle cylinder 9 with one

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of its neighboring cylinders 6, 10 improves, while simultaneously, the cooperation with the other one of the neighboring cylinders deteriorates.

Therefore, the combination of Stein and Gelinas creates obstacles for a person of ordinary skill in the art, which cannot easily be overcome. As can be seen on page 11, lines 1-23 applicants have found solutions for overcoming these obstacles.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 7 or 8. Claims 7 and 8 are, therefore, believed to be patentable over the art and since all of the dependent claims are ultimately dependent on claim 7, they are believed to be patentable as well.

In view of the foregoing, reconsideration and allowance of claims 2, 5, 7, and 8 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel respectfully requests a telephone call so that, if possible, patentable language can be worked out.




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If an extension of time for this paper is required, petition  
for extension is herewith made.

Please charge any other fees which might be due with respect  
to Sections 1.16 and 1.17 to the Deposit Account of Lerner &  
Greenberg P.A., No. 12-1099.

Respectfully submitted,

  
For Applicant(s)

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